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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/516,176	03/01/2000	Takayoshi Sasaki	PM 266297	3428

7590 09/21/2005

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EXAMINER

LE, HOA T

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/516,176	<b>Applicant(s)</b> SASAKI ET AL.	
	<b>Examiner</b> H. T. Le	<b>Art Unit</b> 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 and 10-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,9 and 16-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Interview Summary: Restating Period for Response*

1. This Office action is a replacement of the last office action, mailed September 21, 2005, in response to the request of Applicant's Representative, Mr. Paul White, during the phone conversation on November 8, 2005. Because of the typo in the last office action ("16" having been mistyped as "17"), it was unclear whether claim 16 had been examined as stated on paragraph 2 of the last office action. Accordingly, Applicant requested that the office action be reissued and the statutory response period be restarted. Because it had been more than one month from the mailing date of the last Office action at the time when Applicant's Representative made the inquiry (October 27, 2005), Applicant is given **TWO MONTHS**, instead of three, from the mailing date of this office action within which to submit a response. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

2. As indicated at paragraph 2 of the last office action and confirmed during the phone conversation, claim 16 had been rejoined and examined. However, what should have been claim "16" (on box 6 of the PTOL-236 form and at paragraph 6 on page 4 of the detailed office action) had been inadvertently printed as "17". Thus, the only changes made are formality, i.e. changing the aforementioned occurrences of "17" to "16" and "16" in box 4(a) of form PTOL-325 to "15". The substance of the office action remains the same.

### **Election/Restrictions**

3. Applicant's election with traverse of claims 1-4, 9 and 17-22 in the reply filed on June 15, 2005 is acknowledged. Applicants' request for joining claim 16 to group I invention has been considered and found persuasive. Thus, the elected invention now includes claims 1-4, 9 and 16-22. However, applicant's traversal as to the restriction of other claims is not found persuasive. Applicant argued that claims 5, 6 and 8-10 "depend upon base claim 4", and the common feature that claims 5, 6 and 8-10 shared with claim 4 is "exfoliated titania sol". Therefore, Applicant concluded that "exfoliated titania sol" is a "corresponding special technical features under PCT Rule 13.2." There exists at least one method to obtain "exfoliated titania sol" that is materially different from the process defined in claims 5, 6 and 8-10. Therefore, though the name of the material may be the same, the processes of making the material are different. Therefore, there exists no corresponding special technical feature between claim 4 and claims 5, 6 and 8-10.

The requirement is still deemed proper and is therefore made FINAL. Accordingly, claims 5-8 and 10-16 stand withdrawn from consideration as being drawn to a non-elected invention.

### ***Double Patenting***

4. Claims 1-4 and 9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,863,514. Although the conflicting claims are not identical, they are not patentably distinct from each other for the reasons explained herein.

The “porous body consisting an aggregate” as claimed in the patent claim 1 is same as the “hollow particles” as recited in the instant claim. The dimensions recited in patent claim 1 are within the claimed range recited in the instant claims. The “lamina shaped particles” is just another way to say “laminated particles stuck together” as claimed in the instant claim 1. Claims 2-4 and 9 of the present application are essentially equivalent to claims 2-4 of the patent.

***Claim Rejections - 35 USC § 102***

5. Claims 1-4, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by the Sasaki patent (US 5,863,514).

Claim 1: The Sasaki patent teaches a porous body of titanium oxide having a particle dimensions of 10-30 nm in thickness and 0.5 to 1  $\mu\text{m}$  in width. See claim 1. In other words, the Sasaki patent teaches a hollow (i.e. porous body) titanium oxide particle having the thickness and outer diameter (width) within the claimed ranged. The ‘porous body’ is defined to consist of aggregate of lamina shaped titanium oxide particles. See claim 1. The “lamina shaped particles” is just another way to say “laminated particles stuck together” as claimed.

Claims 3-4 and 9: See claims 2-4.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Sasaki patent (US 5,863,514) as applied to claims 1-4 and 9 above, and further in view of the discussion below.

The Sasaki patent teaches the "hollow particles of titanium dioxide" as claimed. The porous body taught in the Sasaki patent is an aggregate. Pulverizing of an aggregate to obtain acicular or platelet powder is well-known and frequently done in the art if acicular or platelet shaped particles are desired. Therefore, it would have been obvious to one having ordinary in the art to further pulverize the porous body of titanium dioxide taught in the Sasaki patent in order obtain flaky powder that is highly suitable as component in cosmetic composition. Thin, flaky titanium dioxide has been long used as UV-absorbing component in cosmetic composition.

8. Reference not relied upon is cited as art of interest.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'H. T. Le', is positioned above the printed name.

H. T. Le  
Primary Examiner  
Art Unit 1773